REMARKS

Claims 9-11, 13-20, 22, 23, 45, and 46 were pending. Claims 1-8, 12, 21, and 24-44 were previously canceled. In this Reply, claim 9 has been further amended to further clarify the relationships among the steps. Support for amended claim 9 can be found in the specification as filed in at least page 18, line 14 to page 22, line 8. No new matter has been added. After entry of the amendment, claims 9-11, 13-20, 22, 23, 45, and 46 continue to be pending in the present application.

Applicant submits that claims 9-11, 13-20, 22, 23, 45, and 46 are allowable, as discussed below.

Summary of the Office Action

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter.

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 9-11, 13-18, 22, 23, 45, and 46 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,214,579, to Wolfberg et al. (hereinafter "Wolfberg"), in view of U.S. Patent No. 5,884,287, to Edesess (hereinafter "Edesess"). For claims 10-11, the rejection is based on the foregoing combination, further in view of "Official Notice." (See page 8 of Office Action).

Claims 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wolfberg in view of Edesess, and further in view of Lane reference (hereinafter "Lane").

35 U.S.0 § 112, second paragraph

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. The Examiner states that it is not clear how the features in independent claim 9 are related. Specifically, the Examiner states that it is not clear how the step of "generating a projection random number starting point for an initial year in the preselected time period' and the step of "completing a projection method parameters file" are related.

Applicant respectfully submits that these two steps are related in the sense that the projection random number and the parameters identified in the projection method parameters file are all used by the claimed method to perform the projection of the accumulated investment amount for the portfolio. To further clarify this point, applicant further amends the last step of claim 9 to recite "automatically performing, by said computer, the projection of the accumulated investment amount for the portfolio … based on … the random number starting points; and the plurality of parameters identified in the projection method parameters file.

The Examiner also states that the metes and bounds of the "various parameters" limitation are unclear. Applicant respectfully traverses, and notes that the claim language clearly states that the "various parameters" include "a standard deviation of return for the plurality of funds, an average yield for the plurality of funds, and a probability that the average yield for the plurality of funds will exceed a projected yield in any year." Applicant nonetheless amends claim 9 to instead recite "a plurality of parameters including a standard deviation of return for the plurality of funds, an average yield for the plurality of funds, and a probability that the average yield for the plurality of funds will exceed a projected yield in any year." It is believed that this amendment clarifies any confusion of the meaning of "various parameters."

The Examiner further states that it is not clear how claim 15's steps of "inputting the average yield for each of the plurality of funds" and "automatically calculating the average projected yield for each of the plurality of funds" are related to claim 9, because the average yield for each of the plurality of funds is already in the projection method parameters. Applicant respectfully submits that "the average yield for EACH of the plurality of funds" is actually NOT in the projection method parameters. What is included in the projection method parameters is actually "an average yield for the plurality of funds." Therefore, the average yield for each of the plurality of funds needs to be calculated based on the "average yield for the plurality of funds" that is included in the projection method parameters.

The Office Action further suggests that it is unclear how the step of "automatically deducting a service charge" is related to the inputting and automatically calculating steps. Applicant respectfully submits that the automatically deducting a service charge step is related to the automatically performing step of claim 9, because it is the way companies providing service according to the method of claim 9 to receive payment.

Applicant believes that the above claim amendments and explanation clarify any remaining ambiguity in claim 9 and its dependent claims. If the Examiner still believes the claims are unclear, applicant respectfully requests that the Examiner telephone the undersigned to discuss further potential clarifying amendments.

35 U.S.C. S 101

Claims 9-11, 13-20, 22, 23, 45, and 46 were rejected under 35 U.S.0 § 101 as being directed to non-statutory subject matter. The Examiner states that because most of the steps of the claimed method could be performed by human, the computer recited in the last two steps of claim 9 does not play a central role in generating a useful result.

Applicant respectfully submits that the computer recited in the last step of claim 9 indeed plays a central role in generating a useful result. This is because the previous steps are mainly for the purpose of generating the necessary parameters, and the last step of claim 9 is to perform the projection of the accumulated investment amount for the fund portfolio by using the parameters. Because the purpose of the claimed method is to perform such projections for a preselected time period, the step of performing such projection is the central step of the method. Because the central step of performing projection is executed by the computer, the computer is indeed playing a central role in the claimed invention. This useful result, acquired by the programmed computer, informs the user how much accumulated investment is needed to reach the target amount in the preselected number of years. Accordingly, applicant submits that method claim 9 and its dependent claims 10-11, 13-20, 22, 23, 45, and 46 are directed to statutory subject matter, because the computer recited in claim 9 plays a central role in generating the useful projection data. Withdrawal of this rejection is respectfully requested.

35 U.S.C. § 103(a)

Independent claim 9 is directed to a computer implemented method for projecting an accumulated investment amount for a portfolio having a plurality of funds. In the Office Action, claim 9 was rejected under 35 U.S.0 § 103(a) as being unpatentable over Wolfberg in view of Edesess, and further in view of Official Notice. As discussed below, applicant submits that Wolfberg and Edesess fails to show or suggest various features of applicant's independent claim 9, and there is no motivation to combine Wolfberg and Edesess.

First, independent claim 9 recites, among other things, "completing a projection method parameters file in which various parameters are identified, including a standard deviation of return for the plurality of funds, an average yield for the plurality of funds, and a probability

that the average yield for the plurality of funds will exceed a projected yield in any year." The Examiner recognized that Wolfberg fails to show or suggest this feature in applicant's claim 9. (See Office Action, bottom of page 7). The Examiner attempts to make up for this deficiency in Wolfberg by referring to Edesess, but applicant submits that Edesess does not show or suggest this feature either. Specifically, the Examiner contends that Edesess in Figures 2-6 and Column 1, lines 40-52 discloses applicant's feature in claim 9 of "an average yield for the plurality of funds, and a probability that the average yield for the plurality of funds will exceed a projected yield in any year." However, the closest teachings Applicant can find from Edesess are "rate of return" and "expected return for each standard deviation." Assuming, for the sake of argument, that the "rate of return" disclosed by Edesess is equivalent to the "yield" in claim 9, Edesess still does not disclose "average yield" or "<u>probability that the average yield for the plurality of funds will exceed a projected yield in any year</u>." If the Examiner continues to believe that Edesess discloses these features, applicant respectfully requests that the Examiner quote the specific words relied on in Edesess, so that applicant can consider the specific words being interpreted by the Examiner to show these features.

Second, there is no motivation to combine Wolfberg and Edesess, because doing so would change the principle of operation of Wolfberg. MPEP § 2143.01 VI.

Wolfberg teaches a system that manages, monitors and reports the growth of a participant's investment base with respect to progress toward achieving a <u>predetermined target amount</u> selected by the participant. The time frame to achieve the target amount is projected at periodic intervals, e.g. monthly. The impact of such a time frame on the participant's incremental investment, such as increased monthly investment or modified payment cycles, is also reported to the participant. See, e.g., abstract and column 3, lines 45-62. In other words, in

Wolfberg's system, the ultimate target amount is preselected by the participant, but the time frame for achieving the target is a variable that is being projected from time to time.

By contrast, Edesess teaches a system that helps the investor to achieve a wealth goal specified by a predetermined target amount and a specific future date. See, e.g. column 2, lines 31-51. In other ward, in Edesess's system, both the target amount and the date for achieving the target have to be preselected by the investor.

It should also be noted that Wolfberg and Edesess use different algorithms for their calculations, and the Office Action provides no explanation on how these different algorithms could be harnessed together. Here, for the sake of argument, we just assume that their algorithms are inter-changeable.

Now, in order to combine Wolfberg with Edesess, Wolfberg would have to preselect the time frame of achieving the target amount as well. This is a major change to Wolfberg's operation principle, because it will no longer be able to perform its major function, which is periodically projecting the time frame for achieving the target, and a participant will no longer has the flexibility of managing its investments in order to achieve the target amount in different times.

Because combining Wolfberg and Edesess would change the operation principle of Wolfberg, there should be no motivation to combine Wolfberg and Edesess. See MPEP § 2143.01 VI (stating that "[t]he proposed modification cannot change the principle of operation of a reference").

For the foregoing reasons, applicant submits that independent claim 9 is patentable over Wolfberg and Edesess. Accordingly, applicant submits that independent claim 9 is allowable. Claims 10-11, 13-20, 22, 23, 45, and 46 depend upon independent claim 9, and the

rejections of the dependent claims are traversed because "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." (MPEP § 2143.03). Applicant's silence with respect to the particular rejections of the dependent claims should not be construed as a concession that the features of such claims are shown in the cited references. Rather, applicant's silence is based on the belief that the foregoing adequately traverses the rejections of the dependent claims. Applicant hereby reserves the right to address and traverse the specific rejections of any of the dependent claims in the future.

Conclusion

In view of the foregoing, applicant submits that claims 9-11, 13-20, 22, 23, 45, and 46 are allowable. Accordingly, reconsideration and allowance of the application are respectfully requested.

No fees are believed to be due in connection with this paper. However, if any fees are due, please charge any fees due in connection with this Reply to Troutman Sanders LLP Deposit Account No. 20-1507.

Respectfully submitted.

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